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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/604,696

06/26/2000

Philip Carragher

Carr-P1-00

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28710 7590 07/30/2007  
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EXAMINER

KARMIS, STEFANOS

ART UNIT

PAPER NUMBER

3691

MAIL DATE

DELIVERY MODE

07/30/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

Application No.

09/604,696

Applicant(s)

CARRAGHER ET AL.

Examiner

Stefano Karmis

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 03 May 2007.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-49 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-49 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

1. The following communication is in response to Applicant's amendment filed 03 May 2007.

#### ***Status of Claims***

2. There are no new amendments to the claims. Claims 1-49 are pending.

#### ***Response to Arguments***

3. Applicant's arguments filed 03 May 2007 have been fully considered but they are not persuasive.
4. Regarding claims 1-49, Applicant argues that Wilcox fails to teach "crediting the reward to the mortgage, said mortgage including interest." The Examiner respectfully disagrees. Wilcox teaches crediting the reward to the mortgage (column 6, lines 26-55). Wilcox also teaches that mortgages include interest (column 1, lines 22-30; Examiner notes that this is also well known to one of ordinary skill in the art in the financial arts). In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., reward applied to the interest) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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Claim 1 does not state that the reward is credited against the interest of the mortgage. Instead when reasonably interpreted, claim 1 states that the reward is credited to a mortgage (there is no distinction between principal/interest). While claim 1 states, that the mortgage has an interest, claim 1 does not require that the reward be applied to the interest. Therefore, the teachings of Wilcox, in which the reward is applied against the principal of a mortgage, wherein the mortgage also includes an interest amount is sufficient to cover the teachings of claim 1. For these reasons, Applicant's arguments are not persuasive and thus claims 1-49 remain rejected as stated in the previous office action and replicated below.

***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1-5, 17-19, 28, 29, 32, 33, 35, 36, 47 and 48 are rejected under 35 U.S.C. 102(e) as being anticipated by Wilcox et al. (hereinafter Wilcox) U.S. Patent 7,072,851.

Regarding independent claims 1, 28, 32, 47 and 48, Wilcox discloses a method for card activity-based mortgage crediting, the method including the steps of: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward

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by calculating a function responsive to the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39) and generating output including the charge card activity-based mortgage crediting (column 6, lines 26-39).

Claims 2 and 33, further including the step of communicating a funds transfer to the cardholder (column 6, lines 7-39).

Claims 4 and 35, communicating a funds transfer to a mortgage servicer (column 6, lines 7-39).

Claims 5 and 36, communicating includes an electronic funds transfer (column 6, lines 7-39).

Claim 17, computing an annual statement of said crediting, and communicating the statement to the cardholder (column 5, lines 56 thru column 6, line 6).

Claim 18, computing mortgage interest paid by the crediting (column 5, lines 43-55).

Claim 19, associating a monthly payment with the mortgage and communicating a funds transfer including the payment to a mortgage servicer (column 6, lines 8-39).

Claim 29, programming a digital electronic computer to trigger an electronic funds transfer to another digital electronic computer (column 6, lines 26-39).

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 3, 6, 25-27, 30, 34 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al. (hereinafter Wilcox) U.S. Patent 7,072,851 in view of Pettit U.S. Patent 4,722,554.

Regarding claims 3, 6, 25-27, 30, 34 and 37, Wilcox teaches a method for card activity-based mortgage crediting, the method including the steps of: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward by calculating a function responsive to the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39) and generating output including the charge card activity-based mortgage crediting (column 6, lines 26-39). Wilcox teaches payment by check (column 6, lines 26-39). Wilcox fails to specify printing a check for the amount; printing a coupon with the amount for carrying out the payment of the mortgage with the check; and combining the check and the coupon with a statement of the

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card activity in an envelope so as to address the envelope to the cardholder. Pettit teaches an alternative value paper refund form in which a negotiable instrument, nominally a check, and one or more coupons. The form is typically used for a rebate or refund (column 3, lines 30-47 and column 9, lines 3-25). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Wilcox and include payment through postage because it is an efficient manner to transmit payment information stemming from a rebate or refund and is extremely well known in the financial and billing arts.

5. Claims 7, 8, 38 and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al. (hereinafter Wilcox) U.S. Patent 7,072,851 in view of Atkins U.S. Patent 5,644,727.

Claims 7, 8, 38 and 39, Wilcox teaches a method for card activity-based mortgage crediting, the method including the steps of: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward by calculating a function responsive to the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39) and generating output including the charge card activity-based mortgage crediting (column 6, lines 26-39). Wilcox teaches payment by check (column 6, lines 26-39). Wilcox fails to teach forecasting repayment of the mortgage. Atkins teaches the management of accounts that includes the forecasting of mortgage payments (column 43, lines 47-61 and Table 16). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the

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teachings of Wilcox and include forecasting the mortgage payment as taught by Atkins because it elaborates on the statement taught by Wilcox to include specific information regarding the account, that an account holder would deem pertinent.

6. Claims 9-15, and 40-46 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al. (hereinafter Wilcox) U.S. Patent 7,072,851 in view of Atkins U.S. Patent 4,953,085.

Claims 9-15, and 40-46, Wilcox teaches a method for card activity-based mortgage crediting, the method including the steps of: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward by calculating a function responsive to the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39) and generating output including the charge card activity-based mortgage crediting (column 6, lines 26-39). Wilcox teaches payment by check (column 6, lines 26-39). Wilcox fails to teach allocating payment between the interest and principle. Atkins teaches account operation that schedules mortgage payments between the interest and principle (column 12, lines 10-39). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Atkins and include payment to either principle or interest because they both require payments that the customer is interested in allocating the credit.



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7. Claims 16 and 23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al. (hereinafter Wilcox) U.S. Patent 7,072,851 in view of Ogilvie U.S. Patent 6,631,358.

Claims 16 and 23, Wilcox teaches a method for card activity-based mortgage crediting, the method including the steps of: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward by calculating a function responsive to the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39) and generating output including the charge card activity-based mortgage crediting (column 6, lines 26-39). Wilcox teaches payment by check (column 6, lines 26-39). Wilcox fails to teach allocating a portion to charity. Ogilvie teaches directing funds on behalf of a consumer including towards a charity (column 4, lines 11-19). It would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the teachings of Wilcox and include the charity teachings of Ogilvie because Wilcox teaches that the payment can be allocated between numerous accounts including outside accounts. The charity is merely an outside account.

8. Claims 20-22 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al. (hereinafter Wilcox) U.S. Patent 7,072,851.

Claims 20-22, Wilcox teaches a method for card activity-based mortgage crediting, the method including the steps of: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward by calculating a function responsive to

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the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39) and generating output including the charge card activity-based mortgage crediting (column 6, lines 26-39). Wilcox teaches payment by check (column 6, lines 26-39). Wilcox fails to teach the ability to allocate credit activity from a second cardholder. Official Notice is taken that funding from a second cardholder is old and well known in the financial arts. Therefore it would have been obvious to one of ordinary skill in the art to include allocating credit activity from a second cardholder because any number of cards could be added to associate card activity with the mortgage since they all perform in the same manner as the original card used to fund the mortgage.

9. Claim 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al. (hereinafter Wilcox) U.S. Patent 7,072,851 in view of Sullivan U.S. Patent 6,941,279.

Regarding claim 31, Wilcox teaches a method for card activity-based mortgage crediting, the method including the steps of: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward by calculating a function responsive to the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39) and generating output including the charge card activity-based mortgage crediting (column 6, lines 26-39). Wilcox teaches payment by check (column 6, lines 26-39). Wilcox fails to specify that these steps are performed over the internet. Sullivan teaches a mutual fund card method and system that

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associated card activity with a mutual fund wherein payment and receipt are performed over the internet (column 6, lines 50-60). Therefore it would have obvious to one of ordinary skill in the art to modify the teachings of Wilcox and include the teachings of Sullivan because it provides an efficient communication means to allocate payments while associated card contribution to an account of a customer.

10. Claim 24 and 49 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wilcox et al. (hereinafter Wilcox) U.S. Patent 7,072,851 in view of Oppenheimer U.S. Patent 5,983,206.

Regarding independent claim 24 and 49, Wilcox teaches a method for card activity-based mortgage crediting, the method including the steps of: associating card activity with a mortgage of a cardholder (column 3, line 60 thru column 4, line 24); determining a reward by calculating a function responsive to the card activity (column 4, line 41 thru column 5, line 55); crediting the reward to the mortgage, said mortgage including interest (column 6, lines 26-39). Wilcox fails to teach mortgage-backed securities. Oppenheimer teaches a process for creating new mortgage instruments and calculating payment obligations taking into consideration mortgage backed securities (column 4, lines 20-51). Therefore it would have been obvious to one of ordinary skill in the art at the time of the Applicant's invention to modify the reward teachings of Wilcox relating to a mortgage to include the mortgage-backed securities as taught by Oppenheimer because it still outputs a mortgage amount off of which the reward can be determined

*Conclusion*

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

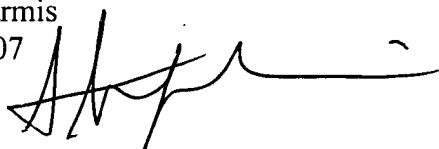
12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Stefano Karmis whose telephone number is (571) 272-6744. The examiner can normally be reached on M-F: 8-5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alex Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Respectfully Submitted  
Stefano Karmis  
23 July 2007



HANI M. KAZIMI  
PRIMARY EXAMINER